

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 37-38, 41-42, 44 and 47 are rejected under 35 U.S.C. 102(b) over the patent to Alanara.

Claims 39-40, 45-46, 52-62, 66-68 and 70 are rejected under 35 U.S.C. 103 over the patent to Alanara in view of the patent to Vanttila.

Claims 33 and 41 are rejected under 35 U.S.C. 103 over the patent to Alanara in view of the patent to Winbladh.

Claim 48 is rejected under 35 U.S.C. 103(a) over the patent to Alanara in view of the patent to Söderbacka.

Claim 65 is rejected under 35 U.S.C. 103 over the patent to Alanara in view of the patent to Vanttila, and further in view of the patent to Söderbacka.

Claim 69 is rejected under 35 U.S.C. 103(a) over the patent to Alanara in view of the patent to Vanttila and Proust.

Claim 63 and 64 are rejected under 35 U.S.C. 103(a) over the patent to Alanara in view of the patents to Vanttila and Hansson.

At the same time, claim 15 is considered as allowable.

The other claims are rejected for formal reasons.

The Examiner's indication of the allowability of claim 50 has been gratefully acknowledged.

In connection with this indication this claim has been canceled and new claim 72 has been submitted which combines the features of the original claims 37, 49 and 50. It is believed that this claim is now in allowable condition.

As for the Examiner's rejection of the claims, the claims have been amended to define that they deal with the method exclusively. Moreover, claim 37 has been amended to distinguish it from the prior art

represented by the U.S. patent 5,604,921, in particular by stating that the notice is different from the short message. This feature is supported on page 13, line 1, to page 14, line 6 and on page 14, line 26, to page 15, line 23.

Claim 48 has been amended to replace the expression "obtaining to" with the expression — issued by —. The support for this expression is disclosed on page 19 by the present application.

Claim 53 has been amended as required by the Examiner. Claim 54 has been amended to depend on claim 54. Claim 56 has been amended to depend on claim 55 and also it has been clarified that "a short message according to the short message service of the level system...".

Claim 58 has been clarified to define that by a command message transmitted to the telecommunications network by the subscriber at least one data field of the short message is processed as a function of the content of the command message. It is disclosed on page 22 of the specification starting from line 21 to page 23 line 12. Claims 61 has not been amended and it is supported on page 24 of the patent application wherein starting from line 10 the meaning of the power scope of the subscriber is explained. This can be for example a video capability of the

subscriber. In claim 69 the expression "which pertains to" has been replaced with --issued by --.

New claim 71, which is a second independent claim, differs from claim 37 by the feature that the notice is transmitted to the subscriber in form of a first data field of the short message, it and combines the features of the original claims 37-39.

Turning now to the Examiner's rejection of the claims over the art, it is believed to be advisable to first of all explain to the Examiner the new features of the present invention as defined in claims 37 and 78.

In these claims it is defined that the notice about the makeup and/or a content of the short message transmitted to the subscriber in dependence on the short message is different from the short message. Thereby it is possible that the subscriber first, on the basis of the notice about the makeup and/or content of the short message, can decide whether he wishes to transmit the short message mainly completely or partially, or based on the possibilities of its station is generally in a position to read the short message.

In accordance with the method defined in claims 37 and 71, the subscriber not only obtains the short message, but also the notice about the makeup and/or content of the short message, separately from the short message.

None of the references teaches these new features of the present invention.

The original claims were rejected over the patent to Alanara as anticipated under 35 U.S.C. 102(b). In connection with this, the Examiner's attention is respectfully directed to the decision in *re Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, this reference does not contain each and every feature as defined now in claim 37 and 71, and therefore the anticipation rejection should be considered as no longer tenable and should be withdrawn.

The present invention as defined in claims 37 and 71 provides for above-mentioned highly advantageous results which can not be accomplished with references. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

This is another important reasons why claims 37 and 71 are patentable.

None of the references provide any hint or suggestion that such features can be or must be provided in them. In order to arrive at the applicant's invention from the teachings of the references, the references have to be fundamentally modified. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

The references do not contain any hint or suggestion for such modifications, and therefore the rejections of the original claims over the combination of the references should be considered as no longer tenable and should be withdrawn.

Claim 37 and 71 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 37, they share their presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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